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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,143	09/24/2001	Brenda F. Baker	RTS-0266	5066

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EXAMINER

SCHULTZ, JAMES

ART UNIT

PAPER NUMBER

1635

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11

Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Amendment

The amendment filed on April 30, 2003 amending all pending claims drawn to the elected invention, and adding new claims such that all of the instant claims are now drawn to non-elected inventions is non-responsive (MPEP § 821.03). The amended and added claims are not readable on the elected invention because the amended and added claims recite multiple and distinct regions of the originally claimed target of SEQ ID NO: 3 which are considered to be distinct from the full target of SEQ ID NO: 3 for reasons of record. In applicant's response dated January 29, 2003, in which restriction to one sequence was required, applicant canceled claim 3 reciting numerous individual sequences and amended claim 1 to recite only the broad target of SEQ ID NO: 3. Said amendment was considered to be responsive to the restriction requirement mailed October 2, 2002, because only one sequence was recited in said claims.

However, applicants' instant amendment is directed to multiple discrete sequences that are contained within the original target. Furthermore, applicants have added new claims that seek to reinstate numerous distinct sequences previously canceled by applicants in a previous response. Such an amendment is considered non-responsive because each individual region necessarily has its own unique nucleotide sequence, each region is a different and discrete region of the target molecule, and each target sequence responds to it unique antisense sequence by increasing or decreasing the expression of the gene to varying degree (per applicants' Table 1 in the specification). Furthermore, a search of more than one of the recited regions presents an undue burden on the Patent Office, because a search for one region does not reveal art against another, and further because, a search for art against the broad target of the originally claimed target of SEQ ID NO: 3 does not result in a complete and exhaustive list of all art directed

against all of applicants newly defined regions. Therefore, because the entirety of applicants' response is dependent on claims encompassing multiple distinct target regions that are considered to be unrelated for reasons of record, said response is not considered to be responsive. In summary, applicants are directed to select one target sequence or one antisense sequence from the instant claim set.

Applicants have argued that the examiner did not establish that the originally filed claim 3 lacked unity of invention and suggest that the sequences recited therein share both a common utility and a substantial structural feature of hybridizing to the target.

In response it is maintained that the instant sequences do not share a common utility. While each may bind to the target, each may not be substituted one for the other since each targets a different site on the target, and furthermore, as per applicants table 1 in the specification, each sequence provides varying levels of inhibition. Similarly, the instant sequences do not share a substantial structural feature. Applicant is reminded that the shared "structural feature" cited by applicant, wherein each of the numerous sequences hybridizes to the target, is not a structural feature at all, but a functional feature, since the term "hybridizing" does not describe a structure but an activity. If it were a shared structural feature as claimed by applicant, then any cellular protein that binds to the target, such as any member of the cellular translation machinery including ribosomes and tRNAs would also be considered to share a substantial structural feature with any of applicants claimed antisense sequences as defined by applicant. Thus, applicants' definition of what a shared structural feature is is not considered reasonable, and applicants' arguments that the instant antisense sequences possess unity of invention is not considered convincing.

Finally, applicants are reminded that the restriction requirement under consideration was made final in the previous Office action, and was made under 35 U.S.C. § 121 and is therefore not a species election, as suggested by applicants.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Douglas Schultz whose telephone number is 703-308-9355. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 703-308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

James Douglas Schultz, PhD

JOHN L. LEGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600